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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/209,454	12/11/1998	HIDENARI TANAKA	88125/ASAHIN	6958

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EXAMINER

LASTRA, DANIEL

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 03/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/209,454

Applicant(s)

TANAKA ET AL.

Examiner

DANIEL LASTRA

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 15-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

1. Claims 15-20 have been examined.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlueter, Jr. et al (U.S. 5,974,124) in view of Eggleston et al (U.S. 6,061,660).

As per claim 15, Schlueter, Jr. et al. teach:

A method of selling prescription contact lenses comprising:

“transferring a customer identification, address, and diagnostic data pertaining to a customer from a physician to a contact lens provider through a communication network (see abstract). Schlueter does not teach that the remote computer 100 is located in the contact lens provider, however the transmitting steps would be performed the same regardless of the data and the location of the information processing apparatus. Thus, this descriptive material would not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). It would have been obvious to a person of ordinary skill in the art at the time the application was made, to collect different types of diagnosis data from a customer and to transmit or receive diagnosis data from one processing apparatus to another.

The subjective interpretation of the data does not patentably distinguish the claimed invention.

Schlueter does not expressly teach, "assigning a registration number to the customer and storing the registration number assigned in relationship with the customer identification and diagnostics data transferred to the provider. However, lines 38-44 of column 2 teach of medical readings taken in the medical office that are uploaded to a centralized database via the Internet. If the Internet is used, adequate security precautions are taken to prevent unauthorized access to the information. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that to transmit data via the Internet, the Schlueter system would register its users and assign password to them as this is a well known method to control access to customer data in the Internet.

Schlueter does not teach, "providing the registration number assigned and selling agent locality data in geographical relation to the customer address data from the contact lens provider to the customer through the communication network and providing the registration number, the customer identification data, and the diagnostic data from the contact lens provider to the selling agent through the communication network".

However, Eggleston teaches a system that registers its customers and compares the geographic information of the consumer with selling localities to identify the nearest selling locality for fulfillment of incentives (see column 22, lines 1-6). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Schlueter system would transmit customer address and

diagnostic data to a central computer to use it to contact the nearest located sellers, as taught by Eggleston.

As per claim 16, Schlueter, Jr. et al fail to teach:

The method of Claim 15, wherein a service charge is paid by the contact lens provider to the selling agent upon monthly payment by the customer". However, Official Notice is taken that is well known in the business art that sellers may receive commissions for bringing business to service providers.

As per claim 17, Schlueter, Jr. et al. teach:

A method of selling prescription contact lenses comprising:

"transferring a customer identification, address, and diagnostic data pertaining to a customer from a physician to a contact lens provider through a communication network (see abstract). Schlueter does not teach that the remote computer 100 is located in the contact lens provider, however the transmitting steps would be performed the same regardless of the type of data and the location of the information processing apparatus. Thus, this descriptive material would not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). It would have been obvious to a person of ordinary skill in the art at the time the application was made, to collect different types of diagnosis data from a customer and to transmit or receive diagnosis data from one processing apparatus to another. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Schlueter does not expressly teach, "assigning a registration number to the customer and storing the registration number assigned in relationship with the customer identification and diagnostic data transferred to the provider". However, lines 38-44 of column 2 teach of medical readings taken in the medical office that are uploaded to a centralized database via the Internet. If the Internet is used, adequate security precautions are taken to prevent unauthorized access to the information. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that to transmit data via the Internet, the Schlueter system would register its users and assign them passwords as this is a well known method to control access to customer data over the Internet.

Schlueter does not expressly teach, "providing the registration number assigned and selling agent data for a selling agent closest in geographical relation to the customer based on the customer address data, from the contact lens provider to the customer, through the communication network, delivering a contact lens from the selling agent to the customer and transferring deliver data from the selling agent to the contact lens provider through the communication network".

However, Eggleston teaches a system that register its customers and compares the geographic information of the consumer with selling localities to identify the nearest selling locality for fulfillment of incentives (see column 22, lines 1-6). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Schlueter system would transmit customer address and diagnostic data to a central computer to use it to contact the nearest located sellers and

to deliver the contact lens to the customer, as taught by Eggleston. Eggleston does not expressly teach of contact lenses but the transferring of information and the selling of products would be performed the same regardless of the type or kind of data being processed. Thus, this descriptive material would not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that although Eggleston does not mention contact lenses, its invention would apply to any kind of product or incentive. The subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 20, Schlueter, Jr. et al fail to teach:

The method of claim 17, including periodically offering for sale contact lens care articles by the contact lens provider to the customer through the communication network". However, Eggleston teaches a system that provides incentives products via the Internet (see summary of the invention). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that contact lenses would be incentive products, and that Schlueter would use the Eggleston invention to deliver contact lenses to customer if it wishes to do so.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlueter, Jr. et al (U.S. 5,974,124) in view of Eggleston et al (U.S. 6,061,660) and further in view of Dziabo, Jr. et al (U.S. 5,213,760).

As per claim 18, Schlueter, Jr. et al fail to teach:

The method of claim 17, including delivering notification of an approaching deadline to replace the contact lens from the contact lens provider to the customer through the communication network". However, Dziabo, Jr. et al teach that a major problem with contact lenses is that patients do not dispose of the lenses pursuant to the manufacturer's instructions (see column 1). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a contact lens provider would use the Schlueter invention to deliver a notification to the patient of an approaching deadline to replace the contact lens as the health of the patients may be at risk.

As per claim 19, Schlueter, Jr. et al do not teach:

The method of Claim 18, including offering new contact lenses to the customer in exchange for old contact lenses and a monthly payment by the user". However, Official Notice is taken that it is well known in the business art to offer new contact lenses as a substitute for old ones by charging a monthly fee. This transaction is a business decision of the contact lens provider.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

D. L.

Daniel Lastra

March 4, 2002

Eric W. Stamber

**ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
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